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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re divisional application of:

SHIGERU HATAKENAKA

Serial No: 09/618,306

Filed: July 18, 2000

For: VINEGAR USING SEA WATER AND
SEASONING THEREOF

Prior Art Unit: 1761

Prior Examiner: Cano

PETITION TO WITHDRAW ABANDONMENT OF APPLICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the suggestion and request by the Supervisory Examiner Cano, Applicant presents the entire history of the above-identified application below and hereby petitions that the Patent Office withdraw abandonment of the above-identified application, affirm the pending of the application before the Patent Office, and commence examination as soon as reasonably possible based upon the facts as set forth below:

1. The above-identified application was originally filed on July 18, 2000 with claims 1 through 8.
2. An Office Action regarding Restriction of Invention was issued on March 11, 2002, and a response was filed by the undersigned on April 2, 2002, canceling claims 7 and 8.
3. On May 24, 2002, a Non-Final Office Action was issued rejecting all claims 1 through 6, claiming vinegars.
4. In this May 24, 2002 Office Action, the Examiner stated: "said vinegar is not claimed with respect to its chemical or physical makeup, but rather by the method in which it is produced"; as a result, Applicant interpreted this Examiner's language that the Examiner was unclear whether or not the claims were directed to a product or a method of producing the product. Accordingly, in response to the May 24, 2002 Office Action filed by the

undersigned on August 22, 2002, it was clarified that the claims were directed purely to the method by way of canceling claims 1 through 6 and adding new claims 9-14 which are all written for a method for producing vinegar.

5. On December 17, 2002, the Examiner issued a Communication stating that the reply of August 22, 2002 is not fully responsive because Applicant is now claiming a different invention. In this Communication, the Examiner Curtis Sherrer stated: "Since the above-mentioned reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSION OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)."

6. The December 17, 2002 Communication was received by the undersigned on December 23, 2002 and because the Applicant is located in Japan, the undersigned had difficulty in securing instructions from Applicant in a timely manner due to the Christmas and New Years holidays and the time and distance differences between the U.S. and Japan before the January 17, 2003 due date.

7. As a result, the undersigned was unable to respond to the December 17, 2002 Communication within the one-month period.

8. Since the statutory period to respond to the May 24, 2002 Office Action expired on November 24, 2002 and the Communication from the Examiner Sherrer was dated December 17, 2002 (which was after November 24, 2002), it was the undersigned's understanding that though the statutory period to respond to the May 24, 2002 Office Action had expired, the one-month period set forth by the Examiner was now a new period to respond and this period was extendible, as noted in the December 17, 2002 Communication, for up to five months under the provisions of 37 CFR 1.136(a).

9. Nonetheless, a Notice of Abandonment was issued on January 23, 2003, with a reason for failing to respond to the May 24, 2002 Office Action, and this Notice of Abandonment was received by the undersigned on January 28, 2003.

10. The undersigned called the Assistant Commissioner's Office and spoke with one of the Assistant Commissioner representatives who agreed with the undersigned's understanding of the December 17, 2002 Communication and due date noted therein, and the

officer stated that pursuant to MPEP 7.14.03 and 37 CFR 1.135(c), the one-month time period set forth by the Examiner was in fact a new time period which could be extended for up to five months under the provisions of 37 CFR 1.136(a). Accordingly, the January 23, 2003 Notice of Abandonment was issued improperly.

11. As a result, in view of the fact that the applicant wanted the subject matter to be a process (method for producing vinegar) over a product (vinegar) as indicative in the August 22, 2002 reply, the undersigned filed on February 14, 2003 a Divisional Application under 37 CFR 1.53(d) using the Patent Office form "PTO/SB/29" titled, "Continued Prosecution Application (CPA) Request Transmittal." Along with this Divisional CPA, the undersigned filed a request and payment for a one-month extension of time for the December 17, 2002 Communication, a Preliminary Amendment directing claims to method claims only, and further, for safety sake, a Petition to Withdraw Abandonment of Application in view of the fact that a Notice of Abandonment was issued on January 23, 2004.

12. Despite this February 14, 2003 Divisional CPA accompanied by a Petition and a request for extension of time, a Notice of Improper Request for Continued Examination (RCE) was issued on March 26, 2004. This Notice of Improper RCE says, "Continued examination ... does not apply to an application unless prosecution ... is closed." As stated above, the undersigned (or the Applicant) filed a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) and not an RCE, and it is clear that no Final Office Action had been issued to the above-identified application. Accordingly, the March 26, 2004 Notice of Improper RCE was issued improperly in undersigned's understanding.

13. The undersigned immediately called Ms. Freda Nelson of Examining Group 1700 who issued the March 26, 2004 Notice of Improper RCE and referred her to a copy of the February 14, 2003 Divisional CPA which clearly indicated that it was a Divisional application under 37 CFR 1.53(d). Ms. Nelson agreed with the undersigned and stated that the March 26, 2004 Notice of Improper RCE was improperly sent.

14. The undersigned then asked Ms. Nelson if Applicant needed to do anything further to reply to the Notice of Improper RCE and was assured by Ms. Nelson that nothing else was required, and she said she would withdraw the March 26, 2004 Notice of Improper RCE.

15. Apparently, the Examiner in charge of this case at the time, namely Adam Meyers, did not receive any communication from Ms. Nelson regarding the withdrawal of the March 26, 2004 Notice of Improper RCE, and on October 20, 2005 Examiner Meyers issued a Notice of Abandonment with a reason for failure to respond to the March 26, 2004 Notice of Improper RCE. Apparently, this Notice of Abandonment was issued improperly since it was issued based upon the improperly issued March 26, 2004 Notice of Improper RCE. In the meantime, this October 20, 2005 Notice of Abandonment was sent to the wrong address and never received by the undersigned, and the undersigned discovered this Notice of Abandonment on their own investigation of the Patent Office database, Patent Application Information Retrieval, after not receiving any communication from the Patent Office for a long while; and as of today, no response (or decision) to our Petition to Withdraw Abandonment of Application filed on February 14, 2003 with the Divisional CPA has been issued yet.

16. The matters described above in paragraphs 11 through 15 are pointed out in the RESPONSE (a copy of which is enclosed herewith) filed on April 11, 2006 by the undersigned upon the request of Ms. Nelson.

17. Since the documents referred to in the above paragraphs are all in the Patent Office records and copies thereof would become voluminous, copies are not enclosed herein except those noted otherwise. However, the undersigned will submit the documents upon the request from the Patent Office.

18. In view of the above, it is respectfully submitted that the original application and the present Divisional CPA are duly pending before the Patent Office and two Notices of Abandonment of January 23, 2003 and October 20, 2005 were issued improperly, and therefore it is respectfully requested that the Patent Office withdraw the abandonment of the above-identified application, bring the application back to pending and examine the application to issue office action or notice of allowance as soon as reasonably possible.

19. Though already filed by the undersigned and received by the Patent Office, the undersigned hereby submits, so as to make it clear, a copy of the Divisional CPA and Preliminary Amendment; and it is respectfully requested that the Patent Office charge a petition fee, if such is required for the present Petition, to Koda & Androlia Deposit Account

No. 11-1445.

The undersigned declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the 2 like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Please charge any additional costs incurred by or in order to implement this Petition or required by any requests for extensions of time to KODA & ANDROLIA DEPOSIT ACCOUNT NO. 11-1445.

Respectfully submitted,

KODA & ANDROLIA

By: 

William L. Androlia
Reg. No. 27,177

2029 Century Park East
Suite 1140
Los Angeles, CA 90067-2983
Tel: (310) 277-1391
Fax: (310) 277-4118

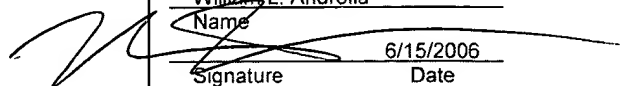
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450, on

June 15, 2006

Date of Deposit

William L. Androlia

Name

 6/15/2006

Signature

Date



I hereby certify that this correspondence is being deposited with the United States Postal

Service as Express Mail No. EL954006584US addressed to:

Commissioner for Patents
Washington, D.C. 20231
Box: CPA

on February 14, 2003 by Inja Yi.

Dated: 2/14/03

By: Inja Yi

10A 2981 DIV

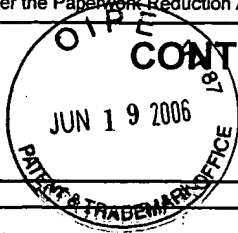
MORI

Applicant:

SHIGERU HATAKENAKA

For:

VINEGAR USING SEA WATER AND SEASONING THEREOF



CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.
(Only for Continuation or Divisional I application under 37 CFR 1.53(d))

CHECK BOX, if applicable:
☐ DUPLICATE

| | | |
|---|------------------------|--------------------|
| Address to: Assistant Commissioner for Patents Box CPA Washington, DC 20231 | Attorney Docket No. | 10A 2981 DIV |
| | First Named Inventor | Shigeru Hatakenaka |
| | Examiner Name | Curtis E. Sherrer |
| | Group Art Unit | 1761 |
| | Express Mail Label No. | EL954006584US |

This is a request for a ☐ continuation or ☒ divisional application under 37 CFR 1.53(d) (continued prosecution application (CPA)) of prior application number 09/618,306 filed on July 18, 2000, entitled VINEGAR USING SEA WATER AND SEASONING THEREOF.

NOTES

FILING QUALIFICATIONS: The prior application identified above must be nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an International application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

C.I.P. NOT PERMITTED: A continuation in part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

EXPRESS ABANDONMENT OF PRIOR APPLICATION: The filing of the CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.59(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of the CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

1. ☐ Enter the unentered amendment previously filed on _____ under 37 C.F.R. 1.116 in the prior nonprovisional application.
2. ☒ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
 - a. ☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:
 - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
 - a. ☐ PTO-1449
 - b. ☐ Copies of IDS Citations

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

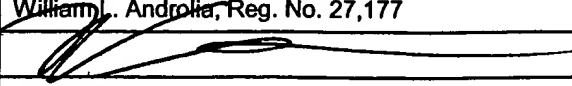
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| CALCULATION OF FEES | | | | | | | |
|-------------------------------------|--|---------------------|-----|-------------------------|---------------------|--|--------|
| ITEM | | TOTAL NO. OF CLAIMS | | NO. OF CLAIMS OVER BASE | LG/SM \$ ENTITY FEE | \$ AMOUNT | \$ FEE |
| A | TOTAL CLAIMS FEE | 6[9] | -20 | 0 | LG=\$18 SM=\$9 | \$9 | \$ 0 |
| B | INDEPENDENT CLAIMS FEE** | 3 | -3 | 0 | LG=\$84 SM=\$42 | \$84 | \$ 0 |
| C | SUBTOTAL - ADDITIONAL CLAIMS FEE (ADD FINAL COLUMN IN LINES A + B) | | | | | | \$ 0 |
| D | MULTIPLE-DEPENDENT CLAIMS FEE | | | | | LARGE ENTITY FEE = \$280 SMALL ENTITY FEE = \$140 | \$ 140 |
| E | BASIC FEE | | | | | LARGE ENTITY FEE = \$750 SMALL ENTITY FEE = \$375 | \$ 375 |
| F | TOTAL FILING FEE (ADD TOTALS FOR LINES C, D, AND E) | | | | | | \$ 515 |
| **LIST INDEPENDENT CLAIMS 9, 10, 14 | | | | | | | |

6. ☒ Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 11-1445 :
- a. ☒ Fees required under 37 CFR 1.16.
- b. ☒ Fees required under 37 CFR 1.17.
- c. ☒ Fees required under 37 CFR 1.18.
8. ☒ Please charge Deposit Account No. 11-1445 in the amount of \$ 515 .
9. ☐ Payment by credit card. Form PTO-2038 is attached.
10. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of _____ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
11. ☒ New Attorney Docket Number, if desired 10A 2981 DIV
12. a. ☐ Receipt for Facsimile Transmitted CPA (PTO/SB/29A)
- b. ☒ Return Receipt Postcard (Should be specifically itemized. See MPEP 503).
13. ☒ Other: Declaration and Power of Attorney and a copy of the prior application as originally filed with an affidavit or declaration verifying it as a true copy

NOTE: The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.

| 14. NEW CORRESPONDENCE ADDRESS | | | | | |
|--|--|---|--|--|--|
| <input type="checkbox"/> Customer Number or Bar Code Label | | (INSERT CUSTOMER NO. OR ATTACH BAR CODE LABEL HERE) | | or <input type="checkbox"/> New correspondence address below | |
| NAME | | | | | |
| ADDRESS | | | | | |
| CITY | | STATE | | ZIP CODE | |
| COUNTRY | | TELEPHONE | | FAX | |

| 15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED | |
|---|--|
| NAME | William J. Androlia, Reg. No. 27,177 |
| SIGNATURE |  |
| DATE | February 14, 2003 |



10A 2981 DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re divisional application of:

SHIGERU HATAKENAKA

For: VINEGAR USING SEA WATER AND
SEASONING THEREOF

Prior Art Unit: 1761

Prior Examiner: Curtis E. Sherrer

PRELIMINARY AMENDMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Please amend the above-identified application which is a 37 CFR §1.53(b) divisional application of Serial No. 09/618,306, as follows:

IN THE CLAIMS:

Please cancel claims 1-8 without prejudice.

Please add new claims 9-14 as follows:

--9. A method for producing vinegar comprising the steps of:

absorbing water to a cereal as a material, said cereal selected from the group consisting of rice, wheat and corn; and

brewing said material with said water to produce vinegar, wherein at least a portion of said water used in said steps comprises at least sea water.

10. A method for producing vinegar comprising the steps of:

steaming a cereal as a material, said cereal selected from the group consisting of rice, wheat and corn, with water; and

brewing said material with said water, wherein at least a portion of said water used in said steps comprises sea water.

11. The method for producing vinegar according to claim 9 or 10 further comprising the step of desalting sea water from a concentration of 10^{-1} to 10^{-3} %.

12. The method for producing vinegar according to claim 9 or 10 further comprising the step of adding clean natural water together with said sea water.

13. The method for producing vinegar according to claim 9 or 10, wherein said sea water comprises a mixture of at least two selected from the group consisting of surface layer sea water, deep layer sea water, concentrated sea water and desalted sea water.

14. A method for producing vinegar comprising the steps of:
preparing water, a portion of said water comprising at least sea water;
mixing together the water and a cereal selected from the group consisting of rice, wheat and corn; and
fermenting the mixture until vinegar is created.--

REMARKS

Applicant has canceled claims 1-8 without prejudice and added new claims 9-14. Applicant would like to point out that the new claims 9-14 clearly claim the method of making the vinegar. Applicant respectfully submits that this is not a change in the invention prosecuted in this application since, as admitted by the Examiner:

“Said vinegar is not claimed with respect to its chemical or physical makeup, but rather by the method in which it is produced.”

Accordingly, Applicant respectfully submits that at best the original claims 1-6 were product-by-process claims, but primarily process. Applicant has therefore amended the claims to make them clearly process claims. Applicant respectfully submits that these amendments to the claims are supported by the application as originally filed and do not contain any new matter. Accordingly, the Office Action will be discussed in terms of the claims as amended.


Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned “Version with markings to show changes made.”

In view of the above, therefore, it is respectfully requested that this Amendment be entered, favorably considered and the case passed to issue.

Please charge any additional costs incurred by or in order to implement this Amendment or required by any requests for extensions of time to KODA & ANDROLIA DEPOSIT ACCOUNT NO. 11-1445.

Respectfully submitted,

KODA & ANDROLIA

By: 
William L. Androlia
Reg. No. 27,177

2029 Century Park East
Suite 3850
Los Angeles, CA 90067
Tel: (310) 277-1391
Fax: (310) 277-4118

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Cancel claims 1-8 without prejudice.

Add new claims 9-14 as follows:

- 9. A method for producing vinegar comprising the steps of:
absorbing water to a cereal as a material, said cereal selected from the group consisting of rice, wheat and corn; and
brewing said material with said water to produce vinegar, wherein at least a portion of said water used in said steps comprises at least sea water.
10. A method for producing vinegar comprising the steps of:
steaming a cereal as a material, said cereal selected from the group consisting of rice, wheat and corn, with water; and
brewing said material with said water, wherein at least a portion of said water used in said steps comprises sea water.
11. The method for producing vinegar according to claim 9 or 10 further comprising the step of desalting sea water from a concentration of 10^{-1} to 10^{-3} %.
12. The method for producing vinegar according to claim 9 or 10 further comprising the step of adding clean natural water together with said sea water.
13. The method for producing vinegar according to claim 9 or 10, wherein said sea water comprises a mixture of at least two selected from the group consisting of surface layer sea water, deep layer sea water, concentrated sea water and desalted sea water.
14. A method for producing vinegar comprising the steps of:
preparing water, a portion of said water comprising at least sea water;

mixing together the water and a cereal selected from the group consisting of rice, wheat and corn; and
fermenting the mixture until vinegar is created.--



10A 2981 DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

SHIGERU HATAKENAKA

Serial No: 09/618,306

Filed: July 18, 2000

For: VINEGAR USING SEA WATER AND
SEASONING THEREOF

Examining Group: 1700

Attention:: Ms. Freda Nelson

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On February 14, 2003, Applicant filed a divisional application under 37 CFR 1.53(d) and attached hereto is a copy of that request. On April 1, 2004, the undersigned received a communication from Ms. Freda Nelson of Examining Group 1700 dated March 26, 2004 and the notice indicated that the divisional application filed on February 14, 2003 was an improper Request for Continued Examination (RCE) and a copy of that communication is attached hereto.

The undersigned reviewed this notice and determined that it was improper and immediately called Ms. Freda Nelson of Examining Group 1700 and referred her to the copy of the request which indicates that it was clearly a divisional application under 37 CFR 1.53(d). Ms. Nelson agreed with the undersigned and stated that the notice was improperly sent.

The undersigned then asked Ms. Nelson if Applicant needed to do anything further to reply to this notice and was assured by Ms. Nelson that nothing else was required and that she would withdraw this notice. Apparently, the Examiner in charge of this case at the time, namely Adam Meyers of Art Unit 1761, did not receive any such notice of withdrawal and on October 20, 2005 abandoned the above-identified application for failure to respond to the notice of improper Request for Continued Examination, a copy of which is attached hereto and which was downloaded from the USPTO website. Apparently, this notice of abandonment was sent to the wrong address and the undersigned and Applicant discovered this holding of abandonment on

their own investigation after not receiving any communication from the Patent Office for a long while.

The undersigned on behalf of Applicant has been attempting to contact the Examiner, namely Mr. Adam Meyers, but has recently discovered that Mr. Meyers has left the Patent Office. As a result, the undersigned has made several attempts to contact Mr. Meyer's Supervisory Examiner, namely Mr. Cano, but so far has been unable to contact even though the undersigned called and left telephonic messages to call the undersigned with Mr. Cano's voicemail.

In addition, the undersigned has further investigated the facts of this case and has discovered that the Examiner entered an interview summary dated October 14, 2005 indicating that the Examiner had a telephonic interview with the undersigned about the undersigned's failure to respond to the notice of improper RCE of March 26, 2004. The undersigned has no recollection of such a telephonic interview and further investigated the file to find if there was any record in Applicant's file whether such an interview had occurred. The undersigned has found no evidence in the file to indicate that there was any such telephonic interview and also inquired with the other members of undersigned's office to determine if anyone else in the office remembers any such telephonic interview or call. The results of this investigation have been entirely negative and no one remembers any such call or inquiry. The only annotation in undersigned's file is an indication that the undersigned called Ms. Nelson again on May 26, 2004 and was assured that the application was still alive and pending.

In view of the facts set forth above, Applicant respectfully submits that Applicant has done all Applicant can do to correct this matter and respectfully submits that the original notice of improper RCE was improperly issued and the notice of abandonment was as a result of a Patent Office mistake.

Respectfully submitted,
KODA & ANDROLIA

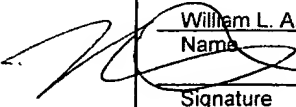
By: 

William L. Androlia
Reg. No. 27,177

2029 Century Park East
Suite 1140
Los Angeles, CA 90067-2983
Tel: (310) 277-1391
Fax: (310) 277-4118

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571) 273-8300 on April 11, 2006.

 William L. Androlia

Name

Signature

4/11/2006

Date